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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/653,178	09/03/2003	Mark P. Baer	4326P2707	3018
23504	7590	02/15/2006	EXAMINER	
WEISS & MOY PC 4204 NORTH BROWN AVENUE SCOTTSDALE, AZ 85251				AGARWAL, MANUJ
		ART UNIT		PAPER NUMBER
		3764		

DATE MAILED: 02/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/653,178	BAER, MARK P.
	Examiner Manuj Agarwal	Art Unit 3764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 03 September 2003.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-22 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-3,5,6,8-15,17- 22 is/are rejected.

7) Claim(s) 1,2,14,15,17 and 20 is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 03 September 2003 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____	6) <input type="checkbox"/> Other: _____

## DETAILED ACTION

### ***Information Disclosure Statement***

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the valve for injecting fluid into the device must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering

of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Specification***

The abstract of the disclosure is objected to because contains the term "disclosed. The language should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes, "... is disclosed," etc.

Correction is required. See MPEP § 608.01(b).

The disclosure is rejected under 35 U.S.C. 112 first paragraph for failing to provide an adequate written description. Sufficient structural detail of the valve, as well as its self-healing nature is not provided. How large or small is this valve in relation to the massage device? What exactly is a "self-healing" membrane? Is this membrane pressure sensitive? If so, wouldn't it leak during the massage application when the massager applies pressure against the massaged person's body?

***Claim Objections***

Claims 1,2,14,15,17,20 are objected to because of the following informalities:

Regarding claims 1,14,17,20, the statement "so that said housing selectively produces one of warming...and cooling" should be changed to "so that said housing

selectively produces one of warming... OR cooling" since we are selecting one of the two.

Regarding claims 2,15, the gap is stated to be between the inner portions of the first and second members. Stating that is it "located between said first and said opposite second members" is redundant.

Claims 17,20 should be changed to "...warming fluid OR cooling fluid."

Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 8 and 9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The specification fails to provide an adequate description of the valve, as well as the self-healing membrane. It is unclear what structure(s) is being claimed.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim is not a full sentence, but rather a run-on. It is not clear what limitations the claim language is adding.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,2,6,10-14,17,20 are rejected under 35 U.S.C. 102(b) as being anticipated by Johnston (US 6,576,004).

Regarding claims 1,14,17, Johnston discloses a therapeutic thermal device capable of providing a handheld massage to massage a portion of the body of a person. This device comprises a housing having a hollow chamber 110 for containing a fluid 200. Fluid 200 can be heated or cooled to enable the housing to produce the warming or cooling of the portion of the body where it contacts (col. 2. lines 44-45).

Regarding claim 2, the device further comprises a first member 116 and an opposite second member 112. The inner portions of the two said structures have a gap 110 located between them. The outer portion of 116 is manifested as a plurality of protuberances (see fig 3), with a corresponding plurality of indentations. Such an arrangement is shown in the cross section fig 4 to allow the said fluid to flow into the plurality of indentations and into the gap.

Regarding claim 6, Johnston's thermal device is manifested as a wrap. Wraps generally shape to the contours of the body part to which it is applied and encircles the area. Thus, Johnston's device is capable of taking an oblong and curved shape. Such

an arrangement would have the first and second members having substantially the same curvature

Regarding claims 10,11, the first member 116 and second member 112, the two components that make up the housing of the device are made of polypropylene, polyester, or polyethylene (col. 3, lines 23-32). Plastic is a term that covers a range of synthetic or semisynthetic polymerization products. The three compounds listed above are all common plastics. They are furthermore thermoplastics.

Regarding claims 12 and 13, heat capacity is a measurable physical quantity that characterized the ability of a body to store heat. Water in its liquid state has a heat capacity of 4.184 J/(g·K), a number that is significantly higher than most liquid substances. Thus, when the water in fluid 200 (col.1 lines 20-24) is heated, its high heat capacity will enable it to provide a warming effect when applied to a portion of a person's body. Similarly, when water is cooled, its high heat capacity will enable it to provide a cooling effect when applied to a person's body.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3,15 rejected under 35 U.S.C. 103(a) as being unpatentable over Johnston in view of Collins (4,187,575).

Johnston lacks a plurality of lobes located at a plurality of corners and attached to the outer portions of the first and second members. Such an arrangement is disclosed by Collins who teaches a device that is also applied to a portion of a user's body and produces therapy. Fig 4 of his disclosure shows a plurality of lobes 18 connected to a plurality of corners. The lobes furthermore are shown to be attached to the outer portions of a first and second member. Such an arrangement would provide a protruding surface that would contact the body upon the delivery of therapy. It would have been obvious to one of ordinary skill at the time the invention was made to include a plurality of lobes at a plurality of corners as taught by Collins to provide a protruding surface that would supplement the activity of the plurality of protuberances.

Claims 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Johnston in view of Chou (US. 6,622,781).

Johnston lacks a valve in a portion of the housing for injecting the fluid into the hollow chamber of the housing. A valve serving such a purpose is common and documented in the art, for such an opening with a sealing means is necessary for the injection and restoring of a fluid in a chamber. Chou teaches a valve 11 attached to a portion of a housing 1 having a first and opposite second member for injecting liquid 3 (col. 1-2, lines 66-1). He provides no further description of the valve because it is "a known art (col. 2 line 2)." It would have been obvious to one of ordinary skill at the time the invention was made to provide the housing of Johnston with a valve for injecting fluid into its interior for it is common in the art and is taught, for example by Chou, to provide a valve means for the entry of fluid into the interior of a hollow space.

Claims 18,19,21,22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnston in view of Collins, in further view of Chou.

Johnston in view of Collins lacks the aforementioned valve. Chou teaches a method of injecting fluid into the interior of his housing 1 via a valve 11. It would have been obvious to one of ordinary skill at the time the invention was made to include the step of injecting fluid into the housing of Johnston in view of Collins via a valve as taught by Chou in order to provide a means for the entry of fluid into the hollow space.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1. US. 6,129,687. Powell. Rollable Massaging Device. Plurality of protuberances and indentations in first member for the flow of fluid.
2. US. 4,986,076. Kirk. Isothermal cooling method and device. Plurality of protuberances and indentations in the first member containing a fluid.
3. US. 2004/0073281. Caselnova. Thermal Pad and Boot Designated for Applying Hot or Cold Treatment. Plurality of protuberances and indentations in the first member containing a fluid.
4. US. 5,409,500. Dyrek. Versatile Therapeutic Cold Pack. Plurality of protuberances and indentations in the first member containing a fluid.
5. US 2,027,290. Reach. Water Bottle. Plurality of protuberances and indentations in the first member containing a fluid.

6. US. 4,034,787. Ellis. Hot Water Bottle with Ear Warming Projections. Plurality of protuberances and indentations in the first member containing a fluid.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manuj Agarwal whose telephone number is (571) 272-4368. The examiner can normally be reached on Mon to Fri 9:00 AM 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory L. Huson can be reached on (571)272-4887. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Manuj Agarwal  
Patent Examiner

MA



Danton D. DeMille  
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